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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,556	07/20/2004	Steven Lundberg	684.001US5	4363
21186 7590 12/31/2007 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER KOPPIKAR, VIVEK D	
			ART UNIT 3626	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/710,556	Applicant(s) LUNDBERG, STEVEN	
	Examiner Vivek D. Koppikar	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/24/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Claims 1-54 have been examined in this application. This communication is a Final Office Action in response to the "Amendment" and "Claims" filed on September 24, 2007.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over "How to Control Your Company's Legal Costs" by Harry J. Maue (hereinafter referred to as Maue) in view of US Patent Number 5,970,478 to Walker in further view of "Interest and Late Charges: How To Charge Clients" by John Yilek (hereinafter referred to as Yilek) and in further view of US Patent Number 5,649, 117.

(A) As per claim 1, Maue and Walker collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services (e.g. paying bills for a customer (law firm)) to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm. At the time of the invention, it

would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing

an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(B) As per claim 2, in Maue the out-of-pocket cost is a fee paid to a government (Maue: Page 3, Paragraph 1). (Note: Maue does not expressly state that the government agency is the Patent and Trademark office, however, when Maue states that attorneys file motions on behalf of clients the examiner interprets these motions to include documents such as petitions which are frequently filed with a government patent and trademark office.)

(C) As per claim 3, in Walker the out-of-pocket cost is paid by a transfer of funds from the law firm to a third party (e.g. merchant) (Walker: Col. 1, Ln. 14-18). The motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(D) As per claim 4, the combined teachings of Maue in view of Walker do not teach or suggest that the out-of-pocket cost is financed by a financing organization independent of a law firm, however, the examiner takes Official Notice that this feature is well known in the financial services industry and that it is equivalent to a credit card company. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified Maue to include this above recited feature with the motivation of providing the law firm or organization incurring the out-of-pocket expenses with a means of paying bills on time without considering their own cash flow.

(E) As per claim 5, in Maue in view of Walker in view of Yilek in view of Landry the separate charge is determined prior to a transfer of funds to pay the out-of-pocket costs (Note: The examiner takes the position that these "separate" charges are standard provisions in the

credit card industry and are expressed to the consumer (credit account user) in Walker as per the terms of the credit card agreement.) (Walker: Col. 3, Ln. 21-23 and Col. 7, Ln. 38-Col. 8, Ln. 21). The motivation for making this aforementioned modification to the teachings of Maue is the same as set forth in the rejection of claim 1, above.

(F) As per claim 6, Maue, Walker, Yilek and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm.. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a loan of funds to pay respective out-of-pocket cost incurred by the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill

in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-of-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that the separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(G) As per claims 7-10, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively, and are rejected on the same basis.

(H) As per claim 11, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more

clients of the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Walker in view of Maue do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm **and** the service provider receiving a payment from the law firm for the services rendered in connection with the separate charge. (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been

obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(G) As per claims 12-15, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively, and are rejected on the same basis.

(H) As per claim 16, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm.. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Walker in view of Maue do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm and the service provider receiving a payment from the law firm for the services rendered in connection with the separate charge (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue and Walker do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(I) As per claims 17-20, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(J) As per claim 21, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm.. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(K) As per claims 22-25, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(L) As per claim 26, Maue, Walker, Yilek and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln.

10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a loan of funds to pay respective out of pocket costs incurred by the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-of-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(M) As per claims 27-30, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(N) As per claim 31, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm and receiving a payment from the law firm for the services rendered in relation to the separate charges billed to the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the

Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(O) As per claims 32-35, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(P) As per claim 36, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; herein each separate charge relates to a to a loan of funds to pay the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned features from Walker with the

motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm and receiving a payment from the law firm for the services rendered in relation to the separate charges billed to the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing

an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(Q) As per claims 37-40, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(R) As per claim 41, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur “out-of-pocket” expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm.. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm and receiving a payment from the law firm for the services rendered in relation to the separate charges billed to the law firm and receiving a payment from

the law firm for the services rendered in relation to the separate charges billed to the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(S) As per claims 42-45, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(T) As per claim 46, Maue, Walker and Landry collectively teach a method comprising the following steps:

Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17);

Maue does not teach the following steps which are taught by Walker (Col. 5, Ln. 56-Col. 6, Ln. 6): billing a law firm a separate charge in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge is determined automatically using at least one computer and relates to a loan of funds to pay the respective out-of-pocket costs incurred by the law firm and receiving payment from the law firm for the services rendered in relation to transactions involving the financing of the respective out-of-pocket costs incurred by the law firm. (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate

charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that the separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(U) As per claims 47-50, these claims repeat features previously addressed in the rejection of claims 2-5, above, respectively and are rejected on the same basis.

(V) As per claim 51, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a service fee for services rendered by a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however,

Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein each separate charge relates to a cost associated with financing the respective out-of-pocket cost incurred by the law firm. (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(W) As per claim 52, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the

following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a service fee for services rendered by a service provider providing services to a law firm in relation to separate charges assessed for each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm; and wherein the one or more computers are further programmed to determine each separate charge as a function of a financing activity associated with funding the respective out-of-pocket cost incurred by the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln. 10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein the one or more computers are further programmed to determine each separate charge as a function of financing activity associated with funding the respective out-of-pocket cost incurred by the law firm. (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Walker in view of Maue with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other

state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-of-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that the separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(X) As per claim 53, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a separate charge to bill a law firm in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the teachings of Maue with the aforementioned feature from Walker with the motivation of having a means of calculating a price of loaning credit to a client, as recited in Walker (Col. 2, Ln. 41-44). (Note: Walker does not state that the customized credit accounts can be used by a law firm, however, Walker does disclose that its credit accounts are used by clients (Walker: Col. 1, Ln.

10-13) and the examiner takes the position that a client or user of the credit card account of Walker can be and is within the scope of Walker).

Maue in view of Walker do not teach the following which is taught by Yilek: the step wherein the one or more computers are further programmed to determine each separate charge as a function of a cost associated with funding the respective out-of-pocket cost incurred by the law firm. (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

(Y) As per claim 54, Maue teaches the concept that law firms incur "out-of-pocket" expenses (for services) for their clients (Maue: Page 4, Lines 4-17), however Maue does not

teach the following which is taught by Walker (Figures 2-3; Col. 4, Ln. 15-Col. 5, Ln. 21 and Col. 5, Ln. 56-Col. 6, Ln. 6): an apparatus comprising one or more computer systems programmed to: determine a separate charge to bill a law firm in relation to each of a plurality of out-of-pocket costs incurred by the law firm for one or more clients of the law firm.

Maue in view of Walker do not teach the following which is taught by Yilek: wherein the one or more computer are further programmed to determine each separate charge as a function of a financing activity associated with funding the respective out-of-pocket costs incurred by the law firm (Yilek: Page 1, Paragraphs 1-2; Page 2, Paragraph 3; Page 5, Paragraph 2 and Page 6). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with these aforementioned teachings from Yilek with the motivation of having a means of making the combined system of Walker in view of Maue compliant with the Truth in Lending Act and other state laws and regulations (Yilek: Page 1, Paragraph 3) which require attorneys to make disclosures of finance charges (i.e. separate charges in relation to each of the respective out-o-pocket costs) (Yilek: Page 6, Paragraphs 4 and 5).

Maue, Walker and Yilek do not teach that me separate charges are automatically determined, using at least one computer, however, this feature is well known in the art as evidenced by Landry (Col. 36, Ln. 42-45). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined teachings of Maue in view of Walker with the aforementioned teachings from Landry with the motivation of providing an accurate means of providing understandable and complete periodic statements of account activities to clients (payors), as recited in Landry (Col. 35, Ln. 37-42).

Response to Arguments

4. Applicant's arguments with respect to the pending claims (1-54) filed on September 24, 2007 have been considered but are moot in view of the new grounds of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

www.wyomingstatebarfoundation.org/IOLTA_trust.accounts.asp (visited on December 12, 2007).

6. Any inquire concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone numbers for this group are either (571) 273-8300 or (703) 872-9326 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,



Vivek Koppikar

12/17/2007



MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600